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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,793	06/12/2007	Gottfried Brem	KLAUS1.004APC	1110

20995 7590 11/13/2009
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EXAMINER

STALEY, KRISTINA N

ART UNIT	PAPER NUMBER
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3611

NOTIFICATION DATE	DELIVERY MODE
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11/13/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/590,793	Applicant(s) BREM ET AL.	
	Examiner KRISTINA STALEY	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 16-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 16-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Receipt of the applicant's amendment filed 7/29/2009 is acknowledged. The objections to the drawings and the 112 rejection of the previous rejection are hereby withdrawn do to proper correction of those issues. Claims 1 and 16-36 remain pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 16, 19, 21, and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Caisley (WO 02/39810).

Referring to Claims 1, 16, and 25: Caisley discloses a device configured to mark and concurrently collect a sample from an individual (pg. 1, lines 28-32), the device comprising:

a spike (Figure 8, #120); and a female part of a tag (Figure 8, #101), comprising:
a tag part containing a through opening (Figure 4, #26); and

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a chamber including a chamber-part (Figure 4, #1) and a ring-part (Figure 4, #15), wherein the chamber-part is fixed to the ring-part through the opening (Figure 4, #26, opening extends from ear #40 to through to edge of #15, see Figure 3), and wherein the chamber-part is configured to hold a container (Figure 4, recess in #1) for collecting a sample (Figure 1b, #13), wherein the chamber-part and the ring-part are each substantially formed of rigid plastic material (pg. 9, lines 24-25, pg 17, lines 18-19 and lines 29-30), and wherein the spike is configured to receive a device configured to collect a sample and close the container (Figure 1b, #3; pg. 7, lines 10-18), wherein the spike comprises an outer diameter which increases from a front end (Figure 9, #122) to a maximum and decreases stepwise to an outer diameter (Figure 8, #121) essentially corresponding to an inner diameter of the ring-part (Figure 8, #11), to form a head, and the chamber (Figure 8, #11) is configured such that once the head (Figure 8, #120) is introduced into the chamber, the chamber substantially prevents the spike (Figure 8, #150) from being removed from the female part (Figure 8, #110) of the tag (pg. 20, claim 2, lines 5-7).

Referring to Claim 19: Caisley discloses a ring-part (Figure 4, #15) comprising a conical area surrounding a through opening (Figure 4, #26), the conical area configured to assist introduction of a spike head into a ring part (pg. 9, lines 32-35).

Referring to Claim 21: Caisley discloses a chamber-part with protrusions (Figure 3, #17 and #15) configured to extend into recessions formed in a female part (Figure 3, #18) of the tag.

Referring to Claim 24: Caisley discloses a tag marked with an electronic identification device (pg. 4, lines 31-33).

Referring to Claims 26 and 27: Caisley discloses a tag being placed on a non-human animal, namely a pet (pg. 1, lines 15-16).

Claims 29, 30, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Pfistershammer (WO 2004/010773).

Referring to Claim 29: Pfistershammer discloses a method of marking and concurrently taking a sample of an individual (abstract), the method comprising: collecting a tissue sample (Figure 3, #47) from an individual (pg. 10, lines 32-33); and applying a tag (Figure 3, #14) to the individual by connecting a spike (Figure 3, #26) to a chamber (Figure 3, #78) through a ring part (Figure 3, #56), a container (Figure 3, #70) being releasably attached to the chamber, wherein the tissue sample is placed in the container (pg. 10, lines 19-30), the container is closed (pg. 11, lines 3-6), the spike enters the chamber such that the spike cannot be removed from the chamber (pg. 11, lines 21-25), and the closed container containing the tissue sample is released from the chamber (Figure 3, pg. 10, lines 26-30).

Referring to Claim 30: Pfistershammer discloses that the ring part (Figure 3, #56) has a conical area (Figure 3, #62) surrounding a through opening (Figure 2, hole above #62) and the spike (Figures 2 and 3, #26) is assisted into the ring part by the conical area (Figures 2 and 3, pg. 10, lines 19-26).

Referring to Claim 34: Pfistershammer discloses that the individual is a non-human animal (pg. 10, lines 1-2).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caisley (WO 02/39810) as applied to claim 1 above, and further in view of Tarver (US 3,399,478).

Caisley does not specifically teach that the plastic of the tag comprises polyamide. Tarver teaches an ear tag formed of plastic comprising polyamide (col. 1, lines 81-82). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Tarver into the invention of Caisley in order to provide construct a tag out of a material which is non-toxic and would not affect a biological sample in any way.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caisley (WO 02/39810) as applied to claim 1 above, and further in view of Pfistershammer (WO 2004/010773).

Referring to Claim 18: Caisley does not teach the parts of the chamber being connected by ultrasonic welding. Pfistershammer teaches parts of an ear tag being formed by ultrasonic welding (pg. 9, lines 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Pfistershammer into the invention of Caisley as it is a common method for connecting solid state plastics.

Claims 20, 22, 23, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caisley (WO 02/39810) as applied to claims 1 and 25 above, and further in view of Haar et al. (US 6,708,432) (Haar).

Referring to Claim 20: Caisley does not teach a ring part extending through an opening of the female part of the tag to contact a chamber part. Haar teaches an ear tag with a ring part (Figure 8, #42) having a form (Figure 8, #46) extending through an opening (Figure 8, #44) of a female part of a tag (Figure 8, #22) to contact a chamber part (Figure 8, #50) of a chamber (Figure 8, #52). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Caisley in order to provide a more secure fit between the separate pieces of the chamber.

Referring to Claim 22: Caisley does not teach recessions in a ring-part of a chamber into which protrusions extend. Haar teaches protrusions (Figure 8, #54) which

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extend through respective openings (Figure 8, #44) of a female-part of a tag (Figure 8, #22), and protrusions on a ring-part of the tag (Figure 8, #46) which extend into respective recessions of a chamber part (Figure 8, #52). It would have been a simple reversal of parts to one of ordinary skill in the art at the time of the invention to place protrusions on the chamber part and recessions on the ring-part, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Caisley in order to interlock the separate pieces of the tag and avoid accidental damage to the tag when it comes in contact with a hard surface.

Referring to Claim 23: Caisley does not teach a recess around an opening in the female part of the tag for receiving a ring-part of the chamber. Haar teaches an ear tag with a female part of the tag (Figure 8, #22) having a recess (Figure 8, #40) arranged around a through opening (Figure 8, #44) and configured to receive a ring-part (Figure 8, #42) of a chamber (Figure 8, #52). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Caisley in order to more securely attach the ring-part to the female part of the tag and avoid accidental breakage.

Referring to Claim 28: Caisley does not teach tagging a deceased animal. Haar teaches a tag on a deceased animal (col. 1, lines 44-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of

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Haar into the invention of Caisley and tag a deceased animal for consumption purposes.

Claims 1, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfistershammer (WO 2004/010773).

Referring to Claim 1: Pfistershammer teaches a device configured to mark and concurrently collect a sample from an individual (abstract), the device comprising: a spike (Figure 2, #26); and a female part of a tag (Figure 2, #44), comprising: a tag part (Figure 2, #14) containing a through opening (Figure 2, #48); and a chamber including a chamber-part (Figure 2, #78) and a ring-part (Figure 2, #62), wherein the chamber-part is fixed to the ring part through the opening (Figure 2, opening is all that is enclosed by #78), and wherein the chamber-part is configured to hold a container (Figure 2, #70) for collecting a sample, wherein the spike is configured to receive a device (Figure 3, #30) configured to collect a sample and close the container (pg. 11, lines 3-6), wherein the spike comprises an outer diameter which increases from a front end to a maximum (Figure 3, at #24) and decreases stepwise to an outer diameter (Figure 3, of #20) essentially corresponding to an inner diameter of the ring-part (Figure 3, #14) to form a head, and the chamber is configured such that once the head is introduced into the chamber, the chamber substantially prevents the spike from being removed from—the female part of the tag (pg. 11, lines 21-25).

Pfistershammer does not teach the specific material the chamber-part and the ring-part is made of. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose a rigid material, since it has been held to be

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within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended uses as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Referring to Claim 35: Pfistershammer further teaches that the chamber-part is fixed to the ring -part so as to prevent separation of the chamber-part and the ring-part (pg. 9, lines 18-20) and wherein the chamber-part and the ring-part are configured to prevent the spike from being removed from the female part of the tag (pg. 11, lines 21-25).

Referring to Claim 36: Pfistershammer teaches that the ring-part is configured to prevent the spike from being removed from the chamber (pg. 11, lines 21-25). Pfistershammer does not teach the specific material the ring-part is made of. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose a rigid material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended uses as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfistershammer (WO 2004/010773) as applied to claim 29 above, and further in view of Haar (US 6,708,432).

Referring to Claim 31: Pfistershammer does not teach recesses and protrusions on the chamber-part and female part of the tag. Haar teaches a method of applying a tag to an animal wherein the chamber -part (Figure 8, #52) has protrusions (Figure 8, #54) and the female part of the tag (Figure 8, #27) comprises recesses, the method

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comprising inserting the protrusions into the recesses (col. 4, lines 20-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the welding fastener of Pfistershammer for the protrusion/recess fastener of Haar as a simple substitution of one known fastening means for another in order to obtain predictable results. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 8– USPQ2d 1385 (2007).

Referring to Claim 32: Pfistershammer does not teach recesses in a ring-part of a chamber into which protrusions extend. Haar teaches protrusions (Figure 8, #54) which extend through respective openings (Figure 8, #44) of a female-part of a tag (Figure 8, #22), and protrusions on a ring-part of the tag (Figure 8, #46) which extend into respective recessions of a chamber part (Figure 8, #52). It would have been a simple reversal of parts to one of ordinary skill in the art at the time of the invention to place protrusions on the chamber part and recessions on the ring-part, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Pfistershammer in order to interlock the separate pieces of the tag and avoid accidental damage to the tag when it comes in contact with a hard surface.

Referring to Claim 33: Pfistershammer does not teach a recess around an opening in the female part of the tag for receiving a ring-part of the chamber. Haar teaches an ear tag with a female part of the tag (Figure 8, #22) having a recess (Figure 8, #40) arranged around a through opening (Figure 8, #44) and configured to receive a

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ring-part (Figure 8, #42) of a chamber (Figure 8, #52). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Pfistershammer in order to more securely attach the ring-part to the female part of the tag and avoid accidental breakage.

Response to Arguments

Applicant's arguments filed 7/29/2009 have been fully considered but they are not persuasive. In response to the argument of claim 1, the examiner believe that the prior art of Caisley still reads on the limitations as amended. As can be seen in the cited rejection of claim 1 above, the chamber part is fixed to the ring-part through an opening in the tag part as can be seen in Figure 4, where the opening extends completely through the tag part and includes the area where the chamber-part is originally attached to the ring-part.

Applicant's arguments, see page 7, filed 7/29/2009, with respect to the rejection(s) of claim(s) 29 under Caisley have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Pfistershammer as shown above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINA STALEY whose telephone number is (571)270-7816. The examiner can normally be reached on Monday through Thursday, 8:00AM-4PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. S./

Examiner, Art Unit 3611

/Joanne Silbermann/

Primary Examiner, Art Unit 3611